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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,072	08/15/2001	Robert G. Burke	T8466357US	8932

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GOWLING LAFLEUR HENDERSON LLP
COMMERCE COURT WEST, SUITE 4900
TORONTO, ON M5L 1J3
CANADA

EXAMINER

ARNOLD III, TROY G

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 09/11/2003

2

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929,072

Applicant(s)

BURKE ET AL.

Examiner

Troy Arnold

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7/4-5, 8, 9, 10/1-10/5, 11-15, 16/1-5 and 17-22 is/are rejected.
- 7) ☒ Claim(s) 6, 7/6, 10/6 and 16/6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3728

DETAILED ACTION

Specification

The abstract of the disclosure is objected to because of the use of the term "novel". Applicant may not claim his invention to be novel. Correction is required. See MPEP § 608.01(b).

Drawings

Figure 6 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 20 is unclear – does a forefoot portion have a convex curvature with a radius of curvature coincident with a long axis center of rotation, as is shown around point 13 in Fig 7? If so, where is this curvature shown and/or described?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Ellis, III, US Patent No. 5,317,819, hereinafter "Ellis." Regarding claim 1, Ellis teaches an article of footwear comprising an upper as claimed, a midsole/outsole 28 as claimed, where the midsole 28 has a heel region and a convex curvature to the outer face in the heel region. See Fig 15 for example. Regarding claim 2, see Figs 15, 18b, 20d, and 22 b of Ellis. It appears that in at least one of the embodiments taught by Ellis has the transverse radius of curvature coincident and alignable as claimed. Regarding claim 3, see Fig 20e. Once again, it appears that in at least one of the embodiments taught by Ellis has the longitudinal radius of curvature coincident as claimed. See also Daswick who teaches a midsole heel structure with convex (compound) curvature.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3728

Claims 4, 5, 7/4, 7/5, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Skaja. Ellis teaches all the limitations of claim 4 except the region of enhanced flexibility, as claimed. Skaja teaches a region of enhanced flexibility demarcated by grooves 12. It would have been obvious in view of Skaja to one of ordinary skill in the art at the time the invention was made to incorporate the flex region of Skaja into the invention of Ellis for the purpose of making the metatarsal region more flexible and comfortable for walking. Regarding claim 5, see item 12 of Skaja.

Claims 10/1, 10/2 and 10/3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Burke et al. Ellis teaches all the limitations of claim 10/1 except a catalyst having an apex, as claimed. Burke teaches a catalyst which interfaces with the plantar aspect of the foot, and which has an apex for aligning with said target area (see column 3, lines 47-49 of Burke), and capable of applying pressure in the manner claimed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the catalyst of Burke into the invention of Ellis for the purpose of making the midsole more orthopedically beneficial. Regarding the height limitation, Burke specifies between 5.28% and 7.6% of the length of the foot. It clearly would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust the height of the apex of the catalyst of Burke, especially within 0.28%, to suit a particular foot shape or bone structure.

Claims 10/4, 10/5, 11, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Skaja, and further in view of Burke et al. Ellis as modified regarding claim 4 teaches all the limitations of claim 10 except the catalyst as claimed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the catalyst of Burke into the midsole of Ellis as noted in the paragraph above. Regarding claim 11, also see paragraph above. Regarding claims 12 and 14, see Fig 5 of Burke.

Claims 13, 15 and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Skaja and Burke et al, and further in view of Marc and Weitsen. Ellis as modified by Skaja and Burke teaches all the limitations of claims 13 and 15 except the receptacle having sidewalls perpendicular to the outer face of the midsole. Both Weitsen and Marc teach receptacles for accommodating resilient members in midsoles, which have walls perpendicular to the outer face of the midsole. It would have been obvious in view of Marc and Weitsen to one of ordinary skill in the art at the time the invention was made to make the walls of the receptacle of Burke perpendicular to the outsole so as to better retain the resilient member. Ellis as modified regarding claim 15 teaches all the limitations of claim 18 except the heel region including a more compressible cushioning region. Marc teaches a more compressible heel cushion 20. It would have been obvious in view of Marc to one of ordinary skill in the art at the time the invention was made to incorporate a more compressible heel cushion into the invention of Ellis as modified for the purpose of reducing shock to the heel bone. Ellis teaches the limitations of claim 19 as above. Regarding claim 21, Ellis

Art Unit: 3728

structure as modified will flatten to some degree when supporting the weight of a wearer. Regarding claim 22, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a cushioning region such as that taught by Marc 20 into the forefoot of the midsole structure of Ellis as modified, for the purpose of reducing shock in the forefoot area. Ellis' forefoot region will clearly flatten to some degree when supporting the weight of a wearer.

Claims 16/1, 16/2 and 16/3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Marc. Ellis teaches all the limitations of claims 16/1-3 except the heel region including a more compressible cushioning region. Marc teaches a more compressible heel cushion 20. It would have been obvious in view of Marc to one of ordinary skill in the art at the time the invention was made to incorporate a more compressible heel cushion into the invention of Ellis for the purpose of reducing shock to the heel bone.

Claims 16/4 and 16/5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Skaja and further in view of Marc, for the same reason noted in the paragraph above.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Skaja and Burke et al, and further in view of Marc, as above.

Art Unit: 3728

Allowable Subject Matter

Claims 6, 7/6, 10/6 and 16/6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Troy Arnold whose telephone number is 703-305-0621. The examiner can normally be reached on Tuesday-Thursday, 9:30-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Troy Arnold
Examiner
Art Unit 3728

TGA


Mickey Yu
Supervisory Patent Examiner
Group 3700